

## REMARKS

### I. BACKGROUND

Claims 1-19 are pending in the application. Claims 1-15, 18 and 19 are rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,239,867 to Aggarwal (hereinafter "Aggarwal") in view of Newman et al., "a multimedia solution to productivity gridlock: a re-engineered jewelry appraisal system at Zale Corporation," MIS Quarterly v. 18 n. 1, 3/1994 (hereinafter "Newman"), and further in view of Japanese Patent Publication No. 10-91646 to Taido (hereinafter "Taido"). Claims 16 and 17 are objected to as being dependent upon a rejected base claim.

The applicant gratefully acknowledges the examiner's indication that claims 16 and 17 contain allowable subject matter. However, the applicant respectfully traverses the examiner's rejection of claims 1-15 and 18-19 and respectfully requests reconsideration. This amendment is timely filed as it is accompanied by an RCE Transmittal and a petition for a two month extension of time and the requisite fees, therefore, extending the response date to October 5, 2004. Furthermore, with this paper, the applicant has amended the independent claims 1, 8 and 15.

### II. SUMMARY OF PRIOR OFFICE ACTIONS AND RESPONSES

The applicant Peter J. Malnekoff filed a declaration pursuant to 37 C.F.R. § 1.131 ("the Rule 131 Declaration") on August 26, 2003. The Rule 131 Declaration demonstrates that Mr. Malnekoff conceived the invention claimed in this application prior to May 28, 1998, and that Mr. Malnekoff was reasonably diligent in reducing the invention to practice. In the office action dated November 18, 2003, the examiner indicated that the Rule 131 declaration "has been considered but is ineffective to overcome the Aggarwal reference" in the presence of a provisional application 60/068,033, filed on December 18, 1997, upon

which Aggarwal claims its priority. However, the November 18, 2003, office action failed to clearly explain the pertinence of the Aggarwal provisional application and the specific parts thereof used to support the § 103(a) rejections.

In response to the applicant's argument discussing the inadequacy of the Aggarwal provisional application in support of various § 103(a) rejections, in an office action dated May 5, 2004, the examiner cited various parts of the Aggarwal provisional application, specifically: Pages 6, 9 and 14 of an appraisal report of the Aggarwal provisional application and pages 1, 6 and 9 of the Aggarwal provisional application. However, as discussed below, none of these cited sections of the Aggarwal provisional application disclose a fully automated gemstone evaluation system as recited in claim 1.

### **III. CLAIM 1 AND ITS DEPENDENT CLAIMS ARE ALLOWABLE**

Claim 1 recites a gemstone evaluation system having an input device adapted to receive gemstone data without the actual presence of the gemstone, a processing device adapted to compute a pricing estimate for use in an evaluation report and based at least on cut proportions of the gemstone, and an output device adapted to communicate the evaluation report to a system user.

#### **A. Aggarwal Fails To Disclose Creating An Evaluation Report In The Absence Of The Gemstone**

The Aggarwal provisional application does not disclose a gemstone evaluation system that can be used to provide an evaluation report for the gemstone in the absence of the gemstone, in a manner recited by the claim 1. Specifically, while the first page of the Aggarwal provisional application discloses a method of determining a monetary value of a gemstone relative to the measured spectral response of the gemstone, unlike the automated gemstone evaluation system recited in claim 1, the method disclosed on the first page requires the presence of the gemstone to get its spectral response. On the other hand, while

the examiner has cited page 6 of the Aggarwal provisional application disclosing a database used to store various types of text, graphic, audio and video data and capable of generating a report, it is not clear as to what is the nature of the report, and whether the cited database has any type of information related to a gemstone. Aggarwal certainly does not disclose creating an evaluation report without the presence of a gemstone as described in claim 1.

**B. Aggarwal Fails To Disclose Creating An Evaluation Reporting Using Cut Properties**

Similarly, while the examiner suggests that the page 9 of the Aggarwal provisional application discloses a database and an analytical software to produce an appraisal report, it does not disclose producing an evaluation report using cut proportions of the gemstone, as recited in claim 1. Finally, while page 14 of the Aggarwal provisional application discloses that content of a folder are analyzed to prepare an appraisal report, the folder does not include any information about the cut proportions of a gemstone, as used by the automated gemstone evaluation system recited in claim 1. Thus, the claim rejections based on the Aggarwal provisional application are improper and should be withdrawn, despite the examiner's conclusory statement that "upon review of the provisional application, support exists for the claim limitations."

**C. Aggarwal Is Not Available As Prior Art**

The Aggarwal provisional application is not available as a prior art reference, as it does not contain support for the invention claimed in Aggarwal, as required by 35 U.S.C. §112, first paragraph. See, MPEP § 2136.03 IV, ("Filing Date Of U.S. Patent Application Can Only Be Used As The 35 U.S.C. § 102(E) Date If It Supports The Claims Of The Issued Child"). *See also, In re Wertheim, 646 F.2d 527, 537 (CCPA 1981):*

If, for example, the PTO wishes to utilize against an applicant a part of that patent disclosure found in an application filed earlier than the date of the application which became the patent, it must demonstrate that the earlier-filed application contains §§ 120/112 support for the invention claimed in the reference patent.

In this case, the examiner has not, and cannot, demonstrate that the Aggarwal provisional application contains support for the invention claimed in the Aggarwal patent. For example, the Aggarwal provisional application contains no support for claims 25-26, 31, or 35 of the Aggarwal patent. Accordingly, the Aggarwal patent is not entitled to be used as prior art over the present application.

Moreover, even if both Aggarwal and the Aggarwal provisional application are available as prior art, neither of them discloses any gemstone evaluation system that can be used to provide an evaluation report for the gemstone in the absence of the gemstone and using the cut proportions of the gemstone, in a manner recited by the claim 1.

**D. Newman Teaches Away Because It Requires The Presence Of The Gemstone**

Similarly, Newman also requires the actual presence of the gemstone being evaluated, and does not use predetermined gemstone data. See, for example, page 24, where Newman et al. states: "Digital calipers and a highly sensitive digital scale are used to measure and weigh the jewelry. They are connected to the workstation through serial ports." Thus, Newman et al. teaches away from the invention because it indicates that the gemstone must be present, and uses gemstone data that is determined concurrently with the evaluation of the gemstone, rather than using predetermined gemstone data.

**E. There Is No Motivation To Combine With Taido Because Taido Is Not Related To Gemstones**

Finally, while Taido discloses a system for determining price of a jewelry based on market price of a metal used by the jewelry and the weight of the jewelry stored on a computer storage device, Taido fails to disclose a gemstone evaluation system that can be used to provide an evaluation report for the gemstone in the absence of the gemstone and using the cut proportions of the gemstone, in a manner recited by the claim 1. Moreover,

because Taido does not even address the evaluation of gemstones, there is no motivation to combine the art disclosed in Taido with the art disclosed in either Aggarwal or Newman.

**IV. CLAIMS 8 AND 15 AND THEIR DEPENDENT CLAIMS ARE ALLOWABLE**

Claims 8 and 15 and their dependent claims are allowable much for the same reasons as recited above with respect to claim 1.

**V. CONCLUSION**

It is respectfully submitted that this application is now in condition for allowance. Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application towards allowance, she is respectfully invited to contact the undersigned attorney at the indicated telephone number.

Respectfully submitted,

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